

REMARKS/ARGUMENTS

On page 4 of the final Official Action, claims 76, 78, 88 and 90 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary (U.S. Patent 5,852,775) in view of Hoshen (U.S. Patent 5,461,390) and Clark et al. (U.S. Patent 6,611,687). Applicant respectfully traverses.

The policy of the Patent and Trademark Office has been to follow in each and every case the standard of patentability enunciated by the Supreme Court in Graham v. John Deere Co., 148 U.S.P.Q. 459 (1966). M.P.E.P. § 2141. As stated by the Supreme Court:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

148 U.S.P.Q. at 467.

The problem that the inventor is trying to solve must be considered in determining whether or not the invention would have been obvious. The invention as a whole embraces the structure, properties and problems it solves. In re Wright, 848 F.2d 1216, 1219, 6 U.S.P.Q.2d 1959, 1961 (Fed. Cir. 1988).

a) Scope and content of the prior art

Hidary discloses a cellular telephone system with an ad server and a memory for holding various commercial messages. The messages are either generic, or are tailored for specific demographically selected subscribers, or geographic cells. When communication is established either between a subscriber or a nonsubscriber, at least one of them gets either a generic or a specific commercial message. (Hidary, Abstract.)

Hoshen discloses a locator device for monitoring the location of subjects, usable in conjunction with a database system connected to a wireless network, wherein the database system causes a polling signal to be sent periodically to each of the subject's locator devices in the area. The locator device includes a wireless transceiver to receive the polling message and, in response, query a location determination device for the current location of the device. This location is then sent back through the wireless network to the database. The database determines from a record on that particular subject where that subject is supposed to be at that time. If the subject being monitored is not within the area where he or she is supposed to be, then the database may automatically contact law enforcement officials. (Hoshen, Abstract.) In particular, if a stalker's locator device is inactive (step 416 in Hoshen FIG. 4A) or if the stalker not in an approved location (e.g. outside of a polygon in Col. 7 line 1) then the local police are alerted (step 504 in FIG. 5) and if the stalker is close to the victim (step 514 in FIG. 5) then the victim is alerted (516 in FIG. 5). The stalker may be alerted of a perimeter violation or loss of radio contact (Col. 5 lines 64-65).

Clark discloses a method and apparatus for a wireless telecommunication system that provides location-based messages. (Clark, Abstract.) The wireless telecommunication system receives information from a wireless mobile unit and determines that the wireless mobile unit is within a designated region. Information specific to the designated region is received at a centrally located location-based message server. As the traveler enters the designated region, the wireless mobile unit then receives information specific to the designated region such as information relating to traffic problems or desired locations within the region. Alternatively, a problem is identified and designated as relating to a particular region, and wireless mobile units within the designated region are then identified so that information relating to the problem can be output thereto. As such, information specific to a region occupied to a traveler is received. (Clark, Abstract.)

b) Differences between the prior art and the claims at issue

Page 5 of the final Official Action recognizes that Hidary “is silent on determining location in relation to another location object/person and sending an appropriate response/message/alert.” More specifically, with respect to applicant’s claim 76, applicant respectfully submits that Hidary does not disclose or suggest “processing the position location data to determine when the position location data indicates that the wireless communication device becomes in proximity to a certain location and the database of user selections contains a selection of the user of the wireless communication device indicates that the user of the wireless communication device has an interest in receiving an advertisement when the wireless

communication device becomes in proximity to the certain location, ...” With respect to applicant’s claim 88, applicant respectfully submits that Hidary does not disclose or suggest “for processing the position location data by repetitively comparing successive ones of the positions of the wireless communication device, as indicated by the position location data, to a certain location to determine when the position location data indicates that the wireless communication device becomes in proximity to the certain location and the database of user selections contains a selection of the user of the wireless communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to the certain location, ...”

Page 5 of the final Official Action cites Hoshen for teaching “determining if/when two people come in proximity to each other and sending the one person an alert (Abstract, figure 1, C1, L50 to C2, L57.). Hoshen, however, is addressing a substantially different problem in a substantially different environment than that defined in applicant’s claims. In particular, Hoshen is not directed to targeted advertising, in which the advertisement is transmitted to the wireless communication device in response to the processing of the position location data determining that the wireless communication device has become in proximity to the certain location and the database of user selections contains a selection of the user of the wireless communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to the certain location. Instead, Hoshen is directed to a protective system whereby a victim is alerted if/when proximate to an attacker.

Page 5 of the final Official Action cites Clark for teaching “sending location-based messages when a user roams into a certain area (Abstract, figures 4-7 and C2, L40-55.) Clark, however, is addressing a substantially different problem in a substantially different environment than that defined in applicant’s claims. In particular, Clark is directed to a cellular telecommunication system that provides location-based messages to the wireless users. The central problem in Clark is using the cellular structure of the wireless telecommunication system for efficient indexing and distribution of certain location-based messages to the wireless users. As a traveler enters a designated region, the wireless mobile unit receives information specific to the designated region such as information relating to traffic problems or desired locations within the region. The designated regions can be any particular defined area, such as cells or cell sectors for example. (Clark col. 9, lines 9-11.) But a designated region is not a location. For example, locations are positions within a designated region, “such as locations of stores within the designated region, such as restaurants for example ...” (Clark, col. 7, lines 43-45.) Sending information about a cell in a cellular telephone system when a mobile unit travels into a cell is facilitated by the cellular structure of the system. But the cellular structure of the system does not suggest sending information when a mobile unit becomes in proximity to a certain location. More importantly, sending information about a cell in a cellular telephone system when a mobile unit travels into a cell does not suggest transmitting an advertisement to the wireless communication device in response to the processing of the position location data determining that the wireless communication device has become in proximity to the certain location and the database of user selections contains a selection of the user of the wireless communication device

indicating that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to the certain location.

c) The subject matter of the claims would not have been obvious

Page 5 of the final Official Action concludes: “[i]t would have been obvious to one skilled in the art at the time of the invention to modify Hiday, such that the system determines a user’s location and sends appropriate messages in relation to that location/proximity, to provide targeted messages to the user as based on that specific location (eg. alerts, sales, activities, gander, traffic congestion, etc).” Applicant respectfully disagrees. Neither Hiday, Hoshen, nor Clark discloses transmitting an advertisement to the wireless communication device in response to the processing of the position location data determining that the wireless communication device has become in proximity to the certain location and the database of user selections contains a selection of the user of the wireless communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to the certain location.

When determining whether a claim is obvious, an examiner must make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.” In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, “obviousness requires a suggestion of all limitations in a claim.” CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing In re Royka, 490 F.2d 981, 985 (CCPA

1974)). Moreover, as the Supreme Court stated, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR Int’l v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)). A fact finder should be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See Id., 127 S. Ct. at 1742, citing Graham, 383 U. S. at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight.”).

The fact that impermissible hindsight would be required to pick and choose selected features of Hidary, Hoshen, and Clark, and then add the missing elements and modify that combination to reconstruct the applicant’s invention, is clearly evident from evidence of various secondary considerations.

d) Secondary considerations - long felt but unsolved needs, failure of others, copying, and commercial success

The present application claims the benefit of a provisional application No. 60/255,331 filed Dec. 13, 2000. Moreover, basic features of the present invention are found in the applicant’s laboratory notebook pages dated prior to Dec. 13, 2000 and attached to the Rule 131 Declaration of Thomas E. Coverstone dated Feb. 28, 2005, and filed on Feb. 28, 2005 in the present application Ser. 10/020,094.

Subsequent to the applicant's invention and continuing well after the applicant's U.S. Patent Application Pub. 2002/0193122 on Dec. 19, 2002, there have been numerous attempts by others to understand and solve the problem first recognized and solved by the applicant. These attempts by others have met with varying degrees of success. Where the applicant's teachings have been followed, the attempts have been successful, resulting in an emerging world-wide location-based mobile advertising industry.

Recently there has been a chain reaction of corporate acquisitions and joint ventures among mobile device manufactures, mobile carriers, and mobile advertising companies. Anticipated location-based mobile advertising revenue has been a major factor driving these corporate acquisitions and joint ventures. More recently various embodiments of the applicant's inventions have been offered and are being introduced commercially. Moreover, key players in the industry have recently filed their own patent applications on similar embodiments, many years after the applicant's priority date. The true extent of the recent filings by others is not known to the applicant, because of the typical 18-month delay from filing to publication, and the right of U.S. patent applicants to request that their patent applications not be published until a patent is granted.

Evidence of these "secondary considerations" is submitted herewith and cited on a Form 1449 also submitted herewith. Following is a discussion of the more pertinent evidence to show the "nexus" or connection between the various "secondary considerations" and the claimed subject matter.

1) The nature of the problem

The applicant's claims are directed to a system and method for sending advertisements to wireless communication devices based on location determination and previously specified user selections. The location of the wireless communication device determines the source or nature of the advertisement, and the location of the wireless communication device also affects when the advertisement is transmitted to the wireless communication device. A previously specified selection of the user of the wireless communication device indicates that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to a certain location.

For example, as defined in applicant's claim 76, a memory contains a database of user selections. A processor receives the position location data from the position location system and processes the position location data to determine when the position location data indicates that the wireless communication device becomes in proximity to a certain location and the database of user selections contains a selection of the user of the wireless communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to the certain location. An advertisement is transmitted to the wireless communication device in response to the processing of the position location data determining that the wireless communication device has become in proximity to the certain location and the database of user selections contains a selection of the user of the wireless communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to the certain location.

Thus, the applicant's claim 76 is dealing with not only the technology of wireless devices and a position location system, but also human psychology. The technology of a wireless device and a position location system provides a capability of transmitting an advertisement in response to the position location system indicating that the wireless device becomes in proximity to a certain location. Due to human psychology, such an advertisement should not be transmitted unless there is a selection of the user to receive such advertisements. Receipt of an ad when a user has no interest in receiving it not only is annoying but also may interfere with receipt of an important call.

Transmitting an advertisement to a wireless device in response to the wireless device becoming in proximity to a certain location is a kind of "push" service, in contrast to a "pull" service that delivers information directly requested from the user. Since push services are not bound on previous user interactions with the service, they are more complex to establish. See, for example, the discussion of Push versus Pull Services on page 5 of the enclosed copy of Stefan Steiniger et al., Foundations of Location Based Services, 2006. See also FIG. 1 of the enclosed copy of Bruner and Kumar, Attitude toward Location-Based Advertising, Journal of Interactive Advertising, Vol. 7, No. 2, Spring 2007.

2) Attempts by others

One of the early studies of location-based advertising was the European Location Based Advertising (ELBA) project. The midterm report dated Oct. 16, 2003 says on page 6 that the project aims at developing and validating an innovative approach including content aggregation and technology integration for location based advertising. The midterm report concludes on

page 17 with the remark: “Advertising is an import step along the way, but if it is done without permission or is irrelevant, it makes meaningful dialog with consumers virtually impossible.”

One of the first successful mobile advertising companies was Acuity Mobile. Acuity Mobile developed an Embedded Mobile Advertising Platform for delivering “Spot Relevance” in mobile advertising for consumers and advertising, by targeting the right content at the right person, at the right time and in the right location. See the enclosed article by David Murphy, In Search of Spot Relevance, Mobile Marketing Magazine, July 13, 2007.

3) Chain reaction of corporate acquisitions and joint ventures

On Sept. 14, 2009, NAVTEQ, the arm of Nokia dedicated to mobile mapping and advertising, announced that it acquired Acuity Mobile for an undisclosed sum. The deal followed NAVTEQ’s initial \$2.8 million stake in the firm as well as years of licensing its technology. See the enclosed copy of Camille Rickets, Nokia’s NAVTEQ buys Acuity Mobile for location-based advertising, Digitalbeat, Sept. 15, 2009, and the enclosed copy of NAVTEQ® Acquires Acuity Mobile, Acuity Mobile Pres Release, Sept. 14, 2009.

On Nov. 9, 2009, Google announced an agreement to acquire AdMob, a mobile display ad technology provider, for \$750 million. See the enclosed copies of Facts about Google’s acquisition of AdMob posted at google.com; and Robert D. Hoff, Why Google is buying AdMob, BusinessWeek, Nov. 9, 2009.

On about January 6, 2010, Quattro Wireless announced that it was acquired by Apple. See the enclosed copy of Stephen Laughlin, “Apple acquires Ad Firm Quattro for \$275 Million,” Jan. 6,

2010, and Yukari Iwatani Kane, Apple's Quattro Deal Pressures Google, The Wall Street Journal WSJ.com, Jan. 6, 2010.

On Feb. 3, 2010, Apple made the following announcement regarding location-based targeted ads: "If you build your application with features based on a user's location, make sure these features provide beneficial information. If your app uses location-based information primarily to enable mobile advertisers to deliver targeted ads based on a user's location, your app will be returned to you." See the enclosed copy of App Store Tip: Enhance Your App with Core Location, developer.apple.com, Feb. 3, 2010.

On April 8, 2010, Apple announced the iAD Mobile Advertising platform. Apple will sell and host the ads, giving 60% of ad revenue back to developers. See the enclosed copies of Jason Kincaid, Apple Announces iAd Mobile Advertising Platform, TechCrunch, April 8, 2010, and Apple Previews iPhone OS 4, apple.com, April 8, 2010.

4) Commercial introduction

The most advanced system for GPS location-based mobile push advertisements is the NAVTEQ Location Point Advertising system. The NAVTEQ Location Point Advertising system is best understood by watching a video at the navteqmedia.com web site, at navteqmedia.com/pressroom/video. Following is a transcript of the audio portion of the video:

Use Navteq Location Point Advertising to point consumers in your direction via mobile phones and personal GPS devices. Location Point Advertising delivers value added offers with relevant content that entice consumers to take action. Consumers see your ads where and when they are most

receptive to your offer. Engage with consumers while they are near your retail location. They're looking for information, open to incentives, and ready to buy. If you want to send an offer to consumers you can do so when they are five blocks or five miles from your store front. You decide. Picture a busy mom driving home a car full of hungry kids. You can send her an offer for buy one get one sandwiches. When they click your coupon, call or get routed to your location, their actions are measurable, giving you solid ROI. Navteq Location Point Advertising lets you control what, where, when, and how consumers see your message. Navteq Media Solutions. Good advertising moves people, great advertising moves with them.

In the example of a busy mom driving home a car full of hungry kids, the targeted ad is pushed to an above-dash wireless device. A suitable wireless device is a GPS navigation unit as described in the enclosed copy of Chris Harnick, Navteq to serve location-based ads in Nextar GPS system, Mobile Marketer, Aug. 31, 2009. Details of the NAVTEQ Acuity Mobile "Preference Engine" used to determine the content pushed to each wireless device is described in the enclosed copy of The 5 Dimensions of Spot Relevance, acuitymobile.com. The five dimensions of Spot Relevance include user's actual and projected location, user interests, user activity, business goals, and time of day. In real time, the Preference Engine correlates all of the five dimensions to determine the right content to deliver. Moreover, Acuity Mobile provides Spot Relevance using EMAP, which features modular and scalable software architecture. See the enclosed copy of Spot Relevance, acuitymobile.com. Furthermore, all user response is tracked and used to augment the system's understanding of the user's preferences and interests to improve accuracy and to populate the client's customer database. See the enclosed copy of

EMAP, acuitymobile.com. Thus, the elements of applicant's claims 76, 77, and 79 are found in the NAVTEQ Location Point Advertising system as shown in the following claim charts:

Claim 76 of Coverstone Ser. 10/020,094	NAVTEQ Location Point Advertising system as shown in the NAVTEQ video using the NAVTEQ Acuity Mobile "Preference Engine" using EMAP.
A wireless communication system for use with a wireless communication device and a position location system providing position location data indicating positions of the wireless communication device as the wireless communication device moves, said wireless communication system comprising:	The busy mom has an above-dash GPS wireless device, such as a Nextar GPS device, in her car. The five dimensions of Spot Relevance include user's actual and projected location. In real time, the Preference Engine correlates all of the five dimensions to determine the right content to deliver
a memory containing a database of user selections,	The EMAP Platform features modular and scalable software architecture. The five dimensions of Spot Relevance include user interests. The NAVTEQ Acuity Mobile "Preference Engine" stores "user interests" in a database, in order to correlate them

	with the other dimensions in real time.
a processor for receiving the position location data from the position location system and for processing the position location data to determine when the position location data indicates that the wireless communication device becomes in proximity to a certain location and the database of user selections contains a selection of the user of the wireless communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to the certain location, and	In real time, the Preference Engine correlates all of the five dimensions to determine the right content to deliver.
a transmitter for transmitting the advertisement to the wireless communication device in response to the processing of the position location data determining that the wireless	If you want to send an offer to consumers you can do so when they are five blocks or five miles from your store front. The user's actual and projected location is correlated with the other dimensions,

communication device has become in proximity to the certain location and the database of user selections contains a selection of the user of the wireless communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to the certain location.	including the user interests, in real time, to determine the right content to deliver.
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77. The wireless communication system as claimed in claim 76, wherein the position location system is the Global Positioning Satellite (GPS) system.	The busy mom has an above-dash GPS wireless device, such as a Nextar GPS device, in her car.
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79. The wireless communication system as claimed in claim 76, wherein the memory further contains a database of user purchases including a history of purchases	The EMAP Platform features modular and scalable software architecture. The five dimensions of Spot Relevance include user activity. The NAVTEQ Acuity Mobile
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<p>made by the user of the wireless communication device, and</p>	<p>“Preference Engine” stores “user activity” in a database, in order to correlate the user activity with the other dimensions in real time. All user response is tracked and used to augment the system’s understanding of the user’s preferences and interests to improve accuracy and to populate the client’s customer database.</p>
<p>wherein the processor is coupled to the memory for accessing the database of user purchases to determine whether or not the history of purchases made by the user of the wireless communication device indicates that transmission of the advertisement to the wireless communication device may be of interest to the user of the wireless communication device, and the processor is coupled to the transmitter for enabling the transmitter to transmit the advertisement to the wireless communication device only</p>	<p>In real time, the Preference Engine correlates all of the five dimensions to determine the right content to deliver.</p>

when the history of purchases made by the user of the wireless communication device indicates that transmission of the advertisement to the wireless communication device may be of interest to the user of the wireless communication device.	
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One would expect that audio advertisements would be delivered to the drivers using more advanced voice-activated turn-by-turn navigation systems. See the enclosed copy of NAVTEQ Location-Point Advertising Selected by Nobex Technologies Hyper-targeted, location aware advertising inventory available on Nobex Radio Companion.

Yet another company involved in providing location-based advertising is Genasys, which calls its service M-advertising. The Genasys web site says the M-Advertising “service delivers promotional messages or discount offers to users who have opted-in, defined a profile of their tastes/interest, and are currently located in an area targeted by the advertiser. See the enclosed copy of What We Do - Proximity Info & Advertising, genasys.com, downloaded on Feb. 23, 2010.

5) Patents and patent applications by key players on similar embodiments

See the following patents and patent applications cited on the enclosed Form 1449:

Yeh et al. U.S. Patent 7,680,796 issued March 16, 2010 to Google, Inc., on Determining and/or Using Location Information in Ad System.

Yeh et al. U.S. Patent 7,668,832 issued Feb. 23, 2010 to Google, Inc., on Determining and/or Using Location Information in Ad System.

Hamoui U.S. Pat. App. Pub. 2008/0059300 published Mar. 6, 2008 to AdMob, Inc., on Targeting an Ad to a Mobile Device.

Lewis et al. U.S. Pat. App. Pub. 2009/0199107 published Aug. 6, 2009 to Qualcomm Inc., on Platform for Mobile Advertising and Persistent Microtargeting of Promotions.

Ames U.S. Pat. App. Pub. 2010/0036710 published Feb. 11, 2010 to Yahoo! Inc., on Modulation of Geo-Targeting Confidence Thresholds in Network Advertising Systems.

Macintyre et al. U.S. Pat. App. Pub. 2010/0049585 published Feb. 25, 2010 to Eastman Kodak Company, on Concierge - Shopping Widget - Method for User Managed Profile and Selective Transmission Thereof.

Blegen U.S. Pat. App. Pub. 2010/0082397 published April 1, 2010 to Microsoft Corporation, on Predictive Geo-Temporal Advertising.

On page 6 of the final Official Action, applicant's dependent claims 77 and 89 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary (U.S. Patent 5,852,775) in view of Owensby (U.S. Patent 6,647,257). Applicant respectfully traverses.

Owensby discloses a system and method for inserting messages, and in particular, commercial information or advertisements, into a wireless mobile communication. The messages

are targeted to the subscriber on the basis of: the location of the terminal at the time of the wireless mobile communication; demographic and personal preference data pertaining to the subscriber; responses made to the messages previously provided to the subscriber; or the historical movement patterns of the subscriber. In yet another alternative embodiment, the subscriber is queried at the conclusion to select one of several options. Based on the subscriber's response, the system may provide additional information relating to the targeted message; insert another message; forward a voice mail, e-mail, or facsimile copy of the targeted message to the subscriber; or establish a direct link with a representative of the sponsor of the message, such as a telemarketer. (Owensby, Abstract.)

Page 6 of the final Official Action recognizes that Hidary "is silent on wherein the position location system is the Global Positioning Satellite (GPS) system." Page 6 of the final Official Action cites Owensby for "providing targeted messages to a mobile (eg. advertisements etc.) and location determination which can use triangulation, GPS, etc. (see Abstract, C15, L50-60 for advertisements and C12, L30-40 for GPS."

Although Owensby discloses use of the Global Positioning System (Owensby col. 12 lines 30-36; claim 34) to determine the true geographical location of a subscriber's wireless mobile terminal to a degree of precision, Owensby does not disclose transmitting an advertisement to the wireless communication device in response to the processing of the position location data determining that the wireless communication device has become in proximity to the certain location and the database of user selections contains a selection of the user of the wireless

communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to the certain location. Instead, in Owensby, the location of the wireless device is used for the selection of one of a plurality of preselected messages to be targeted to the subscriber, which is inserted into a wireless mobile communication in response to a wireless mobile terminal initiating a wireless mobile communication (Owensby Col. 11 lines 34-49), or at regular intervals during a call (Owensby Col. 19 lines 33-36.) Thus, Owensby teaches “a need will exist for a means of reducing subscriber service charges while maintaining operator profit margins” (col. 2, lines 28-3), and Owensby addresses this need by “inserting commercial information or advertisements before and during C/PCS and GMPCS communications that are targeted to the subscriber of the service.” (Col. 4, lines 11-15.) “The messages to be targeted to the subscriber are chosen from the pre-selected messages, in a manner to be described hereinafter, at the time that a wireless mobile communication is initiated or received by a wireless mobile terminal.” (Col. 4, lines 39-43.) Therefore, applicant respectfully submits that claims 77 and 89 are patentable over Hidary in view of Owensby.

On page 6 of the final Official Action, claims 79-80 and 91-92 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary (U.S. Patent 5,852,775) in view of Owensby (U.S. Patent 6,647,257) and further in view of Taylor 5,530,232. In reply, applicant respectfully traverses.

Taylor discloses a multi-application data card capable of substituting for a plurality of existing single-application data cards. The multi-application data card can be a smart card comprising a memory formed with at least three memory banks or storage areas for storing and updating data relating respectively to at least one authorized holder of the card and at least two authorized applications of the card. Alternatively, the data card can be a conventional card having a magnetic stripe, and the memory functions can be performed at a location remote from the card reader and connected thereto by a data link. In addition, the data card can comprise both a magnetic stripe and solid-state circuitry so that it can be read by a card reader compatible with a magnetic-stripe card or by a card reader compatible with a smart card. In accordance with the invention, a card holder needs to carry just one card for all card uses, both financial and non-financial. (Taylor, Abstract.)

Page 7 of the final Official Action notes that Hidary discloses an example of a subscriber having a four year old car, and the message may be an advertisement from a local car dealer for a new car. In applicant's view, it is unreasonable to interpret the applicant's "history of purchases" so broadly as to be disclosed by the mere fact that a subscriber has a four year old car. There is no disclosure in Hidary of how the user of the wireless communication device came into possession of the four year old car. In addition, applicant's claims 79 and 91 recite "a history of purchases made by the user of the wireless communication device" so that the applicant's purchase history must include more than one purchase by the user.

Page 7 of the final Official Action refers to "historical" data in Owensby e.g., C1, lines 25-35. This is "Historical Response Data relating to the responses made to the targeted messages

previously provided to the subscriber.” However, Owensby does not detail more precisely what this Historical Response Data is other than a statement that it includes the record of the targeted messages previously provided to the subscriber and the responses made to the targeted messages, as well as a record of the geographical location of the subscriber at the time the message was provided to the subscriber. See, e.g., Owensby col. 5 lines 46-67; col. 17 lines 60-65.

Page 7 of the final Official Action cites Taylor for teaching tracking/storing a user’s purchase history. However, Taylor relates to replacing a plurality of credit/debit cards with a single smart card for tracking/storing a user’s purchase history for upkeep of the credit or debit account and automatic tracking of bonus points, award discounts, or coupon equivalents automatically depending upon current purchases and/or history of purchase, broken down by brand and in other ways. (Taylor, col. 1 line 54 to col. 2 line 12.) The use of a smart credit or debit card for moving closer to a so-called cashless society as disclosed in Taylor relates to a substantially different environment and problem than the applicant’s wireless communications system and problem of selecting and delivering advertisements targeted to the wireless communication devices depending on the geographic locations of the wireless devices and certain locations of interest to the users of the wireless devices. Therefore, applicant respectfully submits that claims 79-80 and 91-92 are patentable over Hidary in view of Owensby and Taylor.

In short, applicant has submitted persuasive evidence that development of a suitable “push” service for location-based targeted advertisements has been uniquely challenging for those of ordinary skill in the art, and the applicant’s invention is resulting in an emerging world-wide location-based mobile advertising industry.

Request for Personal Interview

Applicant respectfully requests a personal interview if the Examiner does not find allowable subject matter or if the Examiner would find a personal interview helpful in advancing prosecution of the case.

In view of the above, it is respectfully submitted that the application is in condition for allowance. Reconsideration and early allowance are earnestly solicited.

Respectfully submitted,

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